

REMARKS

This Response is being submitted in response to the Office Action mailed April 21, 2004, relating to the above-identified application. Applicants respectfully traverse and request reexamination and reconsideration. Claims 1-34 remain pending.

I. Summary of the Examiner's Rejections and Objections

Claims 1-5, 7-14, 16-25, and 29-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *Greenberg, et al.* (U.S. Patent No. 5,793,352) in view of *Perlman* (U.S. Patent No. 6,169,879).

Claims 6, 15, and 24 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

II. Telephone Interviews

Applicants wish to thank the Examiner and his Supervisor for the telephone interviews conducted with Applicants' representative. A number of issues were discussed as well as many of the pending independent claims. The Examiner and his Supervisor have advised Applicants that the current rejection of independent claim 7 based on *Greenberg, et al.* in view of *Perlman* was in fact improper. Consequently, independent claim 7 is allowable over the art of record. Likewise, claims 8-18, which depend directly or indirectly from claim 7, are also allowable based on the above representation.

The limitations of independent claim 1 were also discussed with respect to the rejection based on *Greenberg, et al.* in view of *Perlman*. The Examiner and his Supervisor indicated that an amendment of the "a plug for stereo audio output" limitation to further clarify the structural and functional relationships therein may place independent claim 1 in condition for allowance. Independent claim 29, which is substantially similar to independent claim 1, will be examined likewise.

Independent claim 19 was the only independent claim not discussed. Previously, independent claim 26 and claims 27 and 28 had been indicated as allowable.

III. Applicants' Response to the Examiner's Rejections

The Applicants traverse the rejection of the aforementioned claims for the reasons set forth in greater detail below.

Applicants submit that *Greenberg, et al., Perlman*, or any combination thereof fails to disclose, teach or suggest, either implicitly or explicitly, each and every element of Applicants' claimed subject matter, and respectfully request the Examiner to withdraw the rejections.

It is well-established that to establish *prima facie* obviousness, all the claim limitations must be taught or suggested by the prior art. In addition, there must be some teaching, motivation or suggestion in either the prior art, or the references themselves to make the combination asserted by the Examiner.

The Examiner states that:

[R]eferences cannot [be] arbitrarily combined and that there must be some reason why one skill in the art would be motivated to make the proposed combination of the primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1985). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). References are evaluated by what suggest to one versed in the art, rather by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA) 1969.

Applicants respectfully submit that the Examiner's statements are a misrepresentation of current Federal Circuit case law. In *In re Lee*, the Federal Circuit held that the Patent & Trademark Office cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies. 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

"When patentability turns on the questions of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. *See, e.g., McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ('the central question is whether there is a reason to combine [the] references,' a question of fact drawing on the *Graham* factors)."

"The factual inquiry whether to combine references must be thorough and searching." *Id.* It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. *See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 299 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ('a showing of a

suggestion, teaching, or motivation to combine the prior art references is an “essential component of an obviousness holding” (quoting *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1352 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); *In re Dembiczak*, 175 F.3d 994, 999 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) (‘Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.’); *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the application); *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) (“teachings of references can be combined *only* if there is some suggestion or incentive to do so.”) (emphasis in original) (quoting *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).”

“The need for specificity pervades this authority. *See, e.g., In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) (‘particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed’); *In re Roufeet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) (‘even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.’); *In re Fritch*, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination ‘only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references’).”

Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.

One case on which the Examiner release, *In re Bozek*, 57 C.C.P.A. 713, 416, F.2d 1385, 163 USPQ 545 (1969), mentions “common knowledge and common sense.” However, *Bozek* did not hold that common knowledge and common sense are a substitute for evidence, but only that they may be applied to analysis of the evidence. Further, *Bozek* did not hold that objective

analysis, proper authority, and reasoned findings can be omitted from Board decisions. Moreover, *Bozek* does not after thirty-two years of isolation, outweigh the dozens of rulings of the Federal Circuit and the Court of Customs and Patent Appeals that determination of patentability must be based on evidence. This court has remarked, in *Smiths Industries Medical Systems, Inc. v. Vital Signs, Inc.*, 183 F.3d 1347, 1356, 51 USPQ2d 1415, 1421 (Fed. Cir. 1999), that *Bozek's* reference to common knowledge 'does not in and of itself make it so' absent evidence of such knowledge.

Measuring a claimed invention against the standard established in 35 U.S.C. §103 requires the oft-difficult, but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references in the then-accepted wisdom in the field. See, e.g., *W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983). Close adherence to this methodology is especially important in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *Id.*

Case law makes it clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. *In re Dembiczak*, 50 USPQ 2d 164, 1617 (Fed. Cir. 1999). Combining prior art references without evidence of such a suggestion, teaching or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. *Id.*; See, e.g., *Interconnect Planning Corp. v. File*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985). Evidence of a suggestion, teaching or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although "the suggestion more often comes from the teachings of the pertinent references." *Dembiczak* at 1617; *In re Roffet*, 149 F.3d 1350, 1359, 47 USPQ 2d 1453, 1459 (Fed. Cir. 1998) ("The board must identify specifically...the reasons one of ordinary skill in the art would have been motivated to select the references and combine them").

The showing of such suggestion, teaching or motivation must be clear and particular. *Dembiczak* at 1617 (emphasis added); *See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 1340, 1352, 48 USPQ 2d 1225, 1232 (Fed. Cir. 1998).

Broad conclusory statements regarding the teaching of multiple references, standing alone, are not “evidence.” *Dembiczak* at 1617; *See, e.g. Elmurry v. Arkansas, Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ 2d 1129, 1131 (Fed. Cir. 1993); *In re Sichert*, 566 F.2d 1154, 1164, 196 USPQ 207, 217 (CCPA 1977).

Therefore, the Examiner must make particular findings regarding the locus of the suggestion, teaching or motivation to confine the prior art references. *Dembiczak* at 1617 (emphasis added).

A. Rejection of claims 1-5

The high density audio/video input/output interconnection device as defined in amended claim 1, calls for, among other things:

“...a plug for stereo audio output connected to the high density connector via a second cable.”

The structure and associated functionality of the aforementioned limitation is not disclosed in *Greenberg, et al.*, *Perlman*, or any combination thereof. Nor has the Examiner provided recitation where the entirety of the aforementioned limitation is disclosed in *Greenberg, et al.* or *Perlman*. Therefore, claim 1 cannot be obvious under *Greenberg, et al.*, *Perlman*, or any combination thereof.

Applicants request a specific showing by the Examiner of the particular locus of the disclosure or teaching of the aforementioned limitation. In each of the four prior Office Actions, the Examiner has been unable to comply with Applicants’ request for such showing. Consequently, the obviousness rejection of claim 1 by the Examiner is improper under 35 U.S.C. § 103(a) and MPEP § 706.02.

In rejecting claim 1, the Examiner has seemingly ignored the aforementioned limitation and broadly asserted that such ignored limitation is disclosed in *Greenberg, et al.* More specifically, on page 2, paragraph 2 of the Office Action, the Examiner states that

“... Greenberg’s device discloses a block or housing having a longitudinal axis including a top surface, bottom surface, front surface, back surface and side surfaces such that the first and second side surfaces are oppositely disposed (see figs. 1-4); a plurality of jacks (40, 40', 42, 44, 53, 53' 42) for connection with

peripheral devices disposed on the first and second sides surfaces; a recessed portion formed on the first side surface having at least one of the plurality jacks (53) disposed therein; a projection portion formed on the second side surface having at least one of the plurality of jacks (44') disposed therein; a cable (54) associate with the back surface and high density conductor connection at 56, 58 (see fig. 1 col. 3, lines 54-59) with the jacks, the jacks with audio, video, stereo-audio inputs and outputs (see figs. 1-2, 4) with the diagram showing the stereo audio input and output (42, 84, 84'), the video input by using the mouse at 44, 44' to select the input and output at 45, 40, 53, 55) or see col. 1, line 36-56, cols 3-4, lines 21-60)."

As a result of the aforementioned telephone interviews, Applicants understand that the Examiner relies on the following statement as evidence of the disclosure of the aforementioned limitation of amended claim 1:

"...a cable (54) associate with the back surface and high density conductor connection at 56, 58... the stereo audio input and output (42, 84, 84')..."

Applicants submit that such statement fails to disclose the aforementioned limitation or provide an indication of where on the *Greenberg, et al.* device the "a plug for stereo audio output connected to the high density connector via a second cable" is disclosed. The Examiner has not discussed the disclosure, teachings or suggestions of *Perlman* in view of the aforementioned limitation nor how *Greenberg, et al.* might be modified by or combined with the disclosure, teachings or suggestions of *Perlman*. Accordingly, the aforementioned limitation of amended claim 1 is not disclosed in *Greenberg, et al.*, *Perlman*, or any combination thereof.

Applicants submit that the obviousness rejection is improper under 35 U.S.C. § 103(a) or MPEP § 706.02 because each and every limitation of amended claim 1 is not disclosed in *Greenberg, et al.*, *Perlman*, or any combination thereof, nor has the Examiner pointed to any portion of *Greenberg, et al.*, *Perlman*, or any combination thereof which discloses the entirety of the aforementioned limitation.

Consequently, Applicants submit that *Greenberg, et al.*, *Perlman*, or any combination thereof does not render the invention as defined in amended claim 1 obvious because the Examiner has seemingly ignored a principal limitation of amended claim 1, and *Greenberg, et al.*, *Perlman*, and any combination thereof does not disclose a high density audio/video input/output interconnection device having the structure and functionality as defined in amended claim 1. Accordingly, reconsideration and withdrawal of rejection of amended claim 1 is respectfully requested.

Claims 2-5 directly or indirectly depend upon include all limitations of amended claim 1 and are allowable at least for the reasons associated with amended claim 1. Accordingly, reconsideration and withdrawal of the rejection of claims 1-5 is respectfully requested.

B. Rejection of claims 7-14 and 16-18

As discussed above, the Examiner and his Supervisor have represented that independent claim 7 is in condition for allowance.

Claims 8-14 and 16-18, either directly or indirectly, depend upon and include all of the limitations of claim 7 and are allowable at least for the reasons associated with claim 7. Accordingly, reconsideration and withdrawal of the rejection of claims 7-14 and 16-18 is respectfully requested.

C. Rejection of Claims 19-25

Claim 19 is directed to a novel high density audio/video input/output connector block. Claim 19 includes the following limitations, *inter alia*:

“... at least one audio jack disposed on the first and second sides defined in a first planes; and,

at least one video jack disposed on the first and second sides defined in a second plane, where that the first and second planes are substantially parallel such that audio and video jacks are offset.”

The structure and functionality of the aforementioned limitation is not disclosed in *Greenberg, et al.*, *Perlman*, or any combination thereof. Nor has the Examiner provided recitation where the entirety of the aforementioned limitation is disclosed in *Greenberg, et al.* or *Perlman*. Accordingly, claim 19 cannot be obvious under *Greenberg, et al.*, *Perlman*, or any combination thereof. Consequently, the obviousness rejection of claim 19 by the Examiner is improper under 35 U.S.C. § 103(a) and MPEP § 706.02.

In rejecting claim 19, the Examiner has seemingly ignored the aforementioned limitations and broadly asserted that such ignored aforementioned limitations are disclosed in *Greenberg, et al.* or *Perlman*. More particularly, the Examiner asserts that:

“... It would have been obvious at the time the invention was made to a person having ordinary skill in the art to use different arrangement to meet the system design and requirement.”

However, Applicants respectfully submit that the structure of the aforementioned limitations are clearly not disclosed in *Greenberg, et al.*, *Perlman*, or any combination thereof. It

is improper for the Examiner to assert that the aforementioned limitations amount to nothing more than the rearrangement of parts when the Examiner has failed to specifically cite to Applicants where such structure and functionality are disclosed in *Greenberg, et al.*, *Perlman*, or any combination thereof.

Applicants respectfully submit that the Examiner's obviousness analysis is limited to an over-generalized discussion of the cited prior art references and an inapplicable case citation directed to rearrangement of parts which are combined to read on the claimed invention. However, this reference-by-reference limitation analysis and non-specific catch-all case citation fails to demonstrate how the *Greenberg, et al.*, *Perlman*, or any combination thereof teach or suggest the combination to yield the aforementioned limitations. Further, Applicants respectfully submit that there is no motivation or teaching found in any of the references to suggest that modification or combination as suggested by the Examiner would be obvious.

Simply because the teachings of *Greenberg, et al.* or *Perlman* were known does not provide the required motivation to combine necessary to establish prima facie obviousness. The mere fact that one skilled in the art could rearrange the parts of the reference device to meet the terms of the claims is not by itself sufficient to support a finding of obviousness. *Ex parte Chicago Rawhide Manufacturing Company*, 223 USPQ 351, 353 (BPAI 1984). Further, parts or structural elements which have not been disclosed in any cited reference cannot be used to support an obviousness rejection without adequate support or motivation. The prior art must provide a motivation or reason for one skilled in the art, without benefit of Applicants' specification, to make the necessary changes in the reference device. *Chicago Rawhide* at 353. Applicants respectfully submit that the Examiner has failed to present any evidence to support his conclusion that one skilled in the art would have had any motivation to configure the audio jacks and video jacks on both sides of the high density interconnection device in separate offset planes for operator intuitive orientation as required. In fact, all of the jacks on the device in *Greenberg, et al.* are disposed in a single plane and cannot be modified without substantially changing the operation or structure of the device in *Greenberg, et al.*

In accordance with MPEP §2144, Applicants believe that they have specifically pointed out the errors in the Examiner's rejection and request that the Examiner provide specific citation of each and every element of the aforementioned limitations and the parts alleged to be

rearranged by documentary proof from the record. The Examiner has again failed to cite the specific limitations claimed by Applicants.

Applicants submit that the obviousness rejection is improper 35 U.S.C. § 103(a) or MPEP 706.02 because each and every limitation of claim 19 is not disclosed in *Greenberg, et al.*, *Perlman*, or any combination thereof, nor has the Examiner made a showing or pointed to any portion of *Greenberg, et al.*, *Perlman*, or any combination thereof which discloses the entirety of the aforementioned limitation.

Consequently, Applicants submit *Greenberg, et al.*, *Perlman*, or any combination thereof does not render the invention as defined in claim 19 obvious because the Examiner has seemingly ignored these principal limitations of claim 19, and *Greenberg, et al.*, *Perlman*, and any combination thereof does not disclose a high density audio/video input/output interconnection device having the structure and functionality as defined in claim 19. Accordingly, reconsideration and withdrawal of rejection of claim 19 is respectfully requested.

Claims 20-25 directly or indirectly depend upon include all the limitations of claim 19 and are allowable for the reasons associated with claim 19. Accordingly, reconsideration and withdrawal of the rejection of claims 19-25 is respectfully requested.

D. Rejection of Claims 29-33

Claim 29, as discussed above, is substantially similar to independent claim 1 and Applicants submit that independent claim 29 is allowable for the reasons set forth above with respect to independent claim 1. Accordingly, reconsideration and withdrawal of rejection of claim 29 is respectfully requested.

Claims 30-33, either directly or indirectly, depend upon include all limitations of claim 29 and are allowable at least for the reasons associated with claim 29. Accordingly, reconsideration and withdrawal of the rejection of claims 29-33 is respectfully requested.

IV. Allowable Subject Matter and New Claims

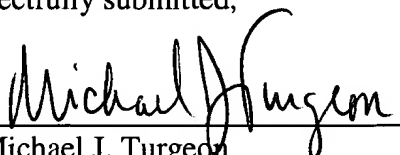
The Applicants wish to thank the Examiner for indicating that the invention as defined in claims 26-28 are allowable over the art of record, and that the invention as defined in claims 6, 15 and 34 would be allowable if re-written in independent form.

CONCLUSION

Based on the above amendments and remarks, the Applicants submit that claims 1-34 are now in proper condition for allowance and such action is earnestly solicited.

The Commissioner is hereby authorized to charge any underpayment or credit any overpayment to Deposit Account No. 50-0441 or any payment in connection with this communication, including any fees for extension of time, which may be required. The Examiner is invited to call the undersigned if such action might expedite the prosecution of this application.

Respectfully submitted,

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